

REMARKS

In the Office Action¹ mailed March 17, 2008, the Examiner rejected claims 7 and 35 under 35 U.S.C. § 112, second paragraph²; rejected claims 1-5, 8, 15, 17-19, 26, 28-33, 36, 43, and 45 under 35 U.S.C. § 102(b) as being anticipated by "The Philadelphia Inquirer Personal Finance Column" by Jeff Brown ("*Brown*"); and rejected claims 6, 7, 9-14, 16, 20-25, 27, 34, 35, 37-42 and 44 under 35 U.S.C. § 103(a) as being unpatentable over *Brown*.

In this Amendment, Applicants amend claims 1, 4, 7, 9-11, 15, 17, 18, 20, 22, 25, 26, 28, 29, 32, 35, 37, 39, 43, and 45. Claims 1-45 are pending and under current examination. Based on the following arguments, Applicants traverse the rejection of claims 1-45.

I. Rejections under 35 U.S.C. § 112

The Examiner rejects claims 7 and 35 under 35 U.S.C. § 112, second paragraph, for "failing to particularly point out and distinctly claim the subject matter which applicant[s] regard as the invention." (Office Action at page 2.) Although Applicants disagree with the Examiner's position, Applicants have amended claims 7 and 35 to recite "wherein the transferred balance is equivalent to an amount an issuer of the financial account pays an original debt holder at the time when the financial account is opened." Applicants submit that claims 7 and 35 are clear and definite and distinctly

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² The Examiner rejects claim 6 in the basis of the rejection, but refers to claim 7 in the body of the rejection. Accordingly, it appears the Examiner intended to reject claim 7 and not claim 6 under 35 U.S.C. § 112. Applicants therefore respond to the Office Action as if the Examiner rejects claim 7. Applicants request clarification in the next communication with Applicants.

claim what Applicants regard as certain embodiments of the disclosed invention. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 7 and 35 under 35 U.S.C. § 112, second paragraph.

II. Rejections under 35 U.S.C § 102(b)

Applicants respectfully traverse the rejections of 1-5, 8, 15, 17-19, 26, 28-33, 36, 43, and 45 under 35 U.S.C. § 102(b). *Brown* fails to disclose each and every element of claims 1-5, 8, 15, 17-19, 26, 28-33, 36, 43, and 45 as amended.

For example, claim 1, as amended, recites a method, including, “defining attributes for the balance transfer sub-account, the attributes comprising a maximum required periodic payment and a maximum interest rate for a transferred balance that are fixed for the life of the financial account at a time when the financial account is opened.” *Brown* does not disclose at least these recitations of claim 1.

Brown discloses a credit company offer to “transfer [] balance from another card and pay a financing charge of zero percent until January 2004.” (lines 1-2.) *Brown* further discloses advice to someone who accepts such an offer to “make required monthly payments, or else you will tumble into default and have to pay finances charges on the zero percent balance.” (lines 26-28). *Brown* also discloses, “be careful to pay off the zero percent balance in full before the term of that offer ends. Miss the deadline, and any unpaid portion will be subject to finance charges.” (lines 29-30). An offer of “a financing charge . . . until January 2004” where “any unpaid portion will be subject to finance charges” when “the term of that offer ends” does not constitute “defining attributes . . . for a transferred balance that are fixed for the life of the financial account at a time when the financial account is opened” (emphasis added), as recited in claim 1.

Brown therefore fails to disclose each and every element of claim 1. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn and the claim allowed.

Independent claims 15, 18, 26, 29, and 43, although of different scope than claim 1, distinguish over *Brown* for at least the same reasons as claim 1. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 15, 18, 26, 29 and 43, under 35 U.S.C. § 102(e) and the timely allowance of the claims.

Dependent claims 2-5, 8, 17, 19, 28, 31-33, 36, and 45 are allowable at least for the reasons set forth above in connection with independent claims 1, 15, 18, 26, 29, and 43, and because they recite features that are not taught or suggested by the cited reference. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2-5, 8, 17, 19, 28, 31-33, 36, and 45 under 35 U.S.C. § 102(e) and the timely allowance of the claims.

III. Rejections under 35 U.S.C. § 103(a)

Applicants also respectfully traverse the rejection of claims 6, 7, 9-14, 16, 20-25, 27, 34, 35, 37-42 and 44 under 35 U.S.C. § 103(a).

The rejection of claims 6, 7, 9-14, 16, 20-25, 27, 34, 35, 37-42 and 44 is legally deficient because the Examiner has not established a *prima facie* case of obviousness. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would

have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Claims 6, 7, 16, 27, 34, 35, and 44 depend from independent claims 1, 15, 18, 26, 29, and 43, and are thus allowable over *Brown* at least for the reasons set forth above in connection with independent claims 1, 15, 18, 26, 29, and 43, and because they recite features not taught or suggested by *Brown*. Further, the Examiner does not cite to any prior art that cures the deficiencies of *Brown* discussed above. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 6, 7, 16, 27, 34, 35, and 44 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Furthermore, the cited prior art relied upon by the Examiner does not teach or suggest the recitations of claims 9-14, 20-25, and 37-42 as amended. For example, claim 9, as amended, recites a method, including, “customizing a pay-off date for a

balance transferred . . . and defining attributes for the balance transferred based on period of time until the pay-off date.”

The Examiner admits that *Brown* does not teach “customizing a pay-off date for [a] balance transferred.” (Office Action at page 7.) However, the Examiner alleges that it “would have been obvious to one of ordinary skill in the art at the time of invention, since it is well known in the art that the payoff timeline is typically one year from the transfer date. Therefore, the user is choosing their payoff date when they choose their transfer date.” (Office Action at page 7.)

The proposition offered by the Examiner is improper because the Office Action has not demonstrated that the elements sought to be combined are “known.” MPEP § 2144.03 states, “[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Here, the Examiner makes general statements without any documentary evidence to support the propositions set forth in the Office Action.

Further, Applicants traverse the Examiner’s position of what “is well known in the art,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” See *id.* Applicants submit that “[d]eficiencies of the cited references cannot be remedied by . . . general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicants request that the Examiner provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” See MPEP § 2144.03.

Here, the Examiner appears to rely upon what is allegedly “well known” within the art. As stated in M.P.E.P. § 2144.03, such assertions are not proper because the Examiner has not demonstrated that the asserted facts were well-known or capable of instant and unquestionable demonstration as being well-known in the art at the time of Applicants’ application. Therefore, the rejection of claim 9 is improper.

Moreover, even assuming that the Examiner’s assertion that “it is well known in the art that the payoff timeline is typically one year from the transfer date” is correct, which the Applicants do not concede, the assertion does not teach or suggest “customizing a pay-off date for a balance transferred . . . and defining attributes for the balance transferred based on period of time until the pay-off date” (emphasis added), as recited in claim 9.

Accordingly, the Examiner has not properly determined the scope and content of the prior art or properly ascertained the differences between the prior art and the invention of claim 9. Indeed, as explained, *Brown* does not teach or suggest “customizing a pay-off date for a balance transferred . . . and defining attributes for the balance transferred based on period of time until the pay-off date” as recited in claim 9 in combination with the other recitation of the claim.

Accordingly, for these reasons, a *prima facie* case of obviousness has not been established with respect to claim 9. Therefore, the rejection of claim 9 under 35 U.S.C. § 103(a) is legally deficient, should be withdrawn, and the claim allowed.

Independent claims 20 and 37, though of different scope than claim 9, are allowable over *Brown* for at least the same reasons as set forth above in connection with claim 9. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 20 and 37, under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Dependent claims 10-14, 21-25, and 38-42 depend from claims 9, 20, and 37, respectively, and are thus also allowable over *Brown* for at least the same reasons set forth above in connection with independent claims 9, 20, and 37. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 10-14, 21-25, and 38-42 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Conclusion


In view of the foregoing amendments and remarks, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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